UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,841	09/30/2003	Simon Chu	RPS920030112US2	4457

45503 7590 04/18/2008

DILLON & YUDELL LLP
8911 N. CAPITAL OF TEXAS HWY.,
SUITE 2110
AUSTIN, TX 78759

EXAMINER	
NEWAY, SAMUEL G	
ART UNIT	PAPER NUMBER
2626	

MAIL DATE	DELIVERY MODE
04/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/674,841	CHU ET AL.	
	Examiner	Art Unit	
	Samuel G. Neway	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-8,10-17 and 19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-8,10-17 and 19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is responsive to the Appeal Brief filed on 04 February 2008.

2. Claims 1 – 4, 6 – 8, 10 – 17, and 19 were appealed.

3. Prosecution is being reopened as the Examiner overlooked a double patenting rejection against Application No. 10/675,614. All other rejections made in the 03 August 2008 final rejection stand. The Examiner regrets any inconvenience this might cause. It is noted that a Terminal Disclaimer has already been filed in Application No. 10/675,614 to overcome a double patenting rejection made in that application against the present application. However, this Terminal Disclaimer is not enough to overcome the double patenting rejection made in this application since a Terminal Disclaimer is effective only with respect to the application in which the Terminal Disclaimer is filed.

Response to Arguments

4. Applicant's arguments filed 04 February 2008 have been fully considered but they are not persuasive.

Appellant's invention is directed to downloading software on a computer depending on the location of the computer. The computer's location is determined and software is downloaded when the computer is deemed to be in an authorized location. In one embodiment authorized location is determined using a local transmitter, in another embodiment, authorized location is *presumed* if no GPS signal is reaching the computer. Claims 1 and 15 require both methods of determining and presuming authorized location at the same time, however this double checking feature was not

disclosed in appellant's specification. It would not have been necessary do double checking of the authorized location, and so to combine these two methods, because one would not need to presume a computer's secure location if the computer's location is already determined.

Double Patenting

5. Claims 1 – 4, 6 – 8, 10 – 17, and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 5, 7 – 13, 15 – 21, 23, and 25 of copending Application No. 10/675,614 in view of Wall (US PGPub 2002/0017977).

Current Application	Application No. 10/675,614
1. A method for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded, the method comprising:	1. A method for regulating execution of a software according to a physical location of a computer on which the software is to be executed, the method comprising:
storing a first list of authorized location ranges where a client computer is authorized to receive a download of a software from a server;	storing a first list of authorized location ranges where a computer is authorized to execute a first software;
determining a physical location of the client computer;	determining a physical location of the computer;
comparing the physical location of the client computer with the first list of authorized location ranges;	comparing the physical location of the computer with the first list of authorized location ranges;
downloading the first software only if the physical location of the client computer is within the range of one of the authorized	executing the first software only if the physical location of the computer is within a range of one of the authorized location

location ranges from the first list of authorized location ranges; and downloading the first software only if the client computer does not receive information derived from a GPS signal. 2. The method of claim 1, further comprising: upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges; comparing the physical location of the client computer with the second list of authorized location ranges, and downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges. 3. The method of claim 1, further comprising: upon determining that the client computer is not located within an authorized area for the requested software download, generating an alert to a software administrator server of the unauthorized area in which the client computer is located while attempting to download a restricted application. …	ranges from the first list of authorized location ranges; and executing the first software only if the client computer does not receive information derived from a GPS signal. 2. The method of claim 1, further comprising: upon determining that the physical location of the computer is not within the first list of authorized location ranges, requesting execution of a second software, the second software having a second list of authorized location ranges; comparing the physical location of the computer with the second list of authorized location ranges, and executing the second software only if the physical location of the computer is within a range of one of the authorized location ranges from the second list of authorized location ranges. 3. The method of claim 1, further comprising: upon determining that the computer is not located within an authorized area, generating an alert to a software administrator server of the unauthorized area in which the computer is located while attempting to execute a restricted software. …

The difference between the current application and Application No. 10/675,614 is that one downloads software depending on location while the other executes software depending on location. Wall discloses both downloading (“information downloaded from the web”, [0035]) executing (“software program executed by processor”, [0101])

depending on location. It would have been obvious to one with ordinary skill in the art to substitute the location dependent software executing process of Application No. 10/675,614 with Wall's location dependent downloading process to yield the predictable result of the current application's claims.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1 – 4, 6 – 7, and 15 – 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification discloses downloading software depending on the location of a computer. The software is downloaded if the location is determined to be secure. The location is determined either by using GPS or from a local enterprise generated signal. In another embodiment, the specification also discloses downloading software when the computer does not detect a GPS signal ([0027]).

Claims 1 and 15 disclose determining the location of a computer (using, for example, a local transmitter, but not GPS) and downloading the software only if the

location is secure and the computer does not receive, or get information derived from, a GPS. Nowhere in the specification is it recited that these two requirements (downloading only if the location is determined to be secure and only if the computer does not receive GPS) should or could occur together. As a matter of fact, the specification in [0027] states that when the computer does not receive a GPS signal, it is assumed that the computer is in a secure location and thus software is downloaded. It would not be obvious from the specification to one with ordinary skill in the art to further verify the location of the computer by checking if it, in fact, is able to receive a GPS signal when the location has already been determined by other means.

Furthermore, from the specification, which states "lack of a GPS … signal being detected by a client computer … enables the loading of an application. Thus, an application may be constructed such that if the GPS receiver 122 does not detect a GPS signal, then it is presumed that the client computer 410 is in a secure location, and the application may be downloaded" ([0027]), it is not clear how the lack of GPS can be a necessary (only if) condition for downloading as in claims 1 and 15, as opposed to a sufficient (enables) one as the specification discloses.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 8, 10 – 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyotoku (USPGPub 2003/0110011) in view of Wall (USPGPub 2002/0017977).

As to claim 8, 19:

Kyotoku discloses a system comprising:

means for storing a first list of authorized location ranges where a client computer is authorized to receive a download of a software from a server (paragraphs 50, 90);

means for determining a physical location of the client computer (paragraphs 55, 92);

means for comparing the physical location of the client computer with the first list of authorized location ranges (paragraphs 57, 93);

means for downloading ("remote access") the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges (paragraph 94, figures 4 and 7);

but he fails to specifically disclose the method further comprising: upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software.

However, Wall discloses a similar method where location is used to control access, use, and viability of software and hardware (Abstract) including downloading a limited use access/usage version of a software ([0103]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to request a second or any number of other downloads in Kyotoku's method, as is done in Wall's method by downloading different versions of software. One would have been motivated to do so because that would enhance Kyotoku's method by extending "the control of the provider to the end user …" (Wall, [0029]).

As to claim 10:

Kyotoku and Wall disclose the system of claim 8, Kyotoku further discloses: upon determining that the client computer is not located within an authorized area for the requested software download, generating an alert ("message") issued to a software administrator server (paragraph 84).

As to claim 11:

Kyotoku and Wall disclose the system of claim 8, Kyotoku further discloses wherein the lists of authorized location ranges are stored in the server (paragraph 93).

As to claim 12:

Kyotoku and Wall disclose the system of claim 8, Kyotoku further discloses wherein the physical location of the computer is determined from a Global Positioning System (GPS) signal (paragraphs 55, 92).

10. Claims 13 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyotoku (USPGPub 2003/0110011) in view of Wall (USPGPub 2002/0017977) and in further view Baese et al. (USPGPub 2002/0082025).

As to claims 13 – 14:

Kyotoku and Wall disclose the method of claim 8, but Kyotoku does not disclose the method wherein the physical location of the computer is determined from a local enterprise generated signal.

Baese discloses using local enterprise generated signals (beacons) to determine location ([0011]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Baese's other alternative path such as local enterprise generated signal to determine physical location. One would have been motivated to use the local enterprise generated signal to determine location in case it is difficult to use GPS for example where GPS broadcast wave cannot reach a GPS receiver.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. G. N./
Examiner, Art Unit 2626

/David R Hudspeth/

Supervisory Patent Examiner, Art Unit 2626